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10/077,889	02/20/2002	Luca Zucchelli	5788-82-01	3819

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EXAMINER

MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
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1714

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DATE MAILED: 07/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/077 889

Applicant(s)

ZUCCHELLI et al

Examiner

MEDLEY

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-6, 9-18, 21-28, 34-37 and 43 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-6, 9-18, 21-28, 34-37 and 43 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/301,309.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

### DETAILED ACTION

Applicants request for a continuation application under 37 C.F.R. section 1,53(b) of the parent application serial No. 09/301,309 filed on April 29, 1999, now Patent 6,375,691 on February 20, 2002 has been made of record. An action on the merits of instant Application Serial No. 0/077,889 follows.

The submission of 9 sheets of formal drawings on May 01, 2002 has been made of record.

Claims 2-6, 9, 11-18, 24-28 and 35 are objected to because of the following informalities: The article "A" should be inserted at the beginning of each of claims 2-6, 9, 11-18, 24-28 and 35 for clarity. A space should be inserted after 0.6 and  $\text{g/cm}^3$  in claim 9 for clarity. Appropriate correction is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-8, 18 and 28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitations for claims 6 and 18 and 28 that the fossil fuel is selected from "mixture thereof" was not found by the examiner described in the originally filed claims and disclosure of the instant claims. Applicants have not pointed out to the examiner

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the location of the said limitation. The newly added limitation of claims 6, 18 and 28 is considered new matter. Critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 23-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over FR 2,273,861 for 80% carbon and

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20% of unvulcanized elastomer particles supplied to a boiler that anticipate the instant claimed combustion method, note the unedited draft English translation, especially examples 1 and 2. If applicants deem the claims not to be anticipated then in the alternative the claims are rendered obvious by the carbon, fossil fuel and elastomer particles of patentees. The term conventional installation boiler of patentees include an instantaneous – combustion boiler that is the apparatus of the instant claims.

Claims 1-6, 9-18, 23-28 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz 4,152,119 combined with Blaustein 4,405,331.

Schultz teaches a method for feeding a boiler with a fuel composition and a fuel composition comprising coal, MSW comprising plastics, and a binder, note Examples 1 and 6 column 4, lines 59 to column 5, lines 1-30 which render the claimed invention obvious.

Blaustein further teach that RFD comprises cellulosic materials, plastic, etc, note column 2, lines 17-40 and that RFD are combined with coal fines, a binder and fly ash, note figure 1 and column 2, lines 41- end and Table 2 of columns 5 and 6 and Examples 1-3. Blaustein further provides state of the art knowledge that plastics are included in the MSW of Schultz, and in RDF. Patentee also teaches that said compositions are further combined with coal fines to provide fuel composition for burning in boilers. It is the examiner's position that at least 90% of the prior art fuel composition will inherently combust in less than 10 seconds because the fuel composition are of the same components and in the same relative proportion especially

in that at least 95% of the composition is instantaneously combusting fuel fossil that inherently combust within 10 second.

Claims 37 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz 4,152,119 combined with Blaustein 4,405,331 as applied to claims 1-6, 9-18, 23-28, 31 and 34-36 above, and further in view of Fr 2,733,302A Gas De France.

Applicants further teach a plant for combusting fuel compositions comprising a boiler, a burner, a feeder, a combustion chamber, and transportation supply means wherein the combined teaching of Schultz and Blaustein are silent to said means.

Patentee FR 2,733,303 teaches that conventional plants that burn household waste comprise a boiler, at least one burner, a feeder, a combustion chamber, and transportation supply means. It would be obvious to the artisan in the art to use the secondary reference plants comprising means that burn household waste as the boiler of the primary reference to burn its fuel composition comprising household waste.

Applicant's arguments filed February 20, 2002 have been fully considered but they are not persuasive.

Contrary to applicants' believe that the specification, for example at page 9, lines 7-8, provide support and that figure 7 illustration of various supply flows 42A, 43A and 45 provides support for newly amended claim 6, 18 and 28 "in which the fossil fuel is selected from the group consisting of methane, fuel oil, fossil coal dust and mixtures thereof". The examiner have carefully studied and considered applicants' selected portion of the disclosure and maintain the position that the said selected passage and figure does not support the amendment made to claims 6, 18 and 28.

Contrary to applicants' arguments presented on page 9 of the preliminary amendment, the argument presented in the footnote is contradictory to the second full paragraph as well as to the amended claims. Claim 23 is of a different scope than the arguments presented in footnote 2 and of a different scope than the paragraph with respect to the Patentee FR '861. The rejection over FR '861 is maintained.

In response to applicant's argument that the agglomerated fuel materials of Schulz can not be used to fuel "instantaneous – combustion", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicants' have not placed any chemical or physical limitation on the fuel composition of claim 1 (and its dependent claims), the fuel of claim 23 (and its dependent claims), the fuel of claim 34 (and 35) and 36. It is further noted that claim 23 (and its dependent claims) claim 34 (and 35) and claim 36 fuel composition does exclude the fuel composition of Schultz and its secondary references. Also, claims 34 and 35 are not directed to an instantaneous combustor. Thus the rejection over Schultz in view of Blaustein is proper.

Applicants' argument directed to claims 37 and 43 have been carefully considered and studied. However, it is noted on record that claims 37 and 43 are apparatus claims and the intended method steps argued of record are not proper for apparatus which invention lies in the means of the apparatus and not in the intended

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steps of the process for operating the apparatus. Thus the rejection of claims 37 and 43 is proper over Schulz and the secondary references.

The prior art cited but not applied further teach fuel compositions and components, methods and apparatus of the same nature as claimed by applicants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday-Friday from 7:30 am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
MARGARET MEDLEY  
PRIMARY EXAMINER

Examiner Medley/mn  
July 25, 2002